SCHULTE ROTH & ZABEL LLP

919 Third Avenue
New York, NY 10022
(212) 756-2000
fax (212) 593-5955

www.srz.com

Official

RECEIVED 3/9/03

FACSIMILE
PLEASE DISTRIBUTE TO ALL LISTED PERSONS

To	Company	Fax No.	Confirmation No.
Examiner Richard Ellis	U.S. Patent & Trademark Office, Group 2183	703 746 7238	703 305 3900
Supervisory Examiner Eddie Chan		703-305-9731	703-305-9712

FROM:	David E. Boundy	**DATE:**	March 9, 2003
DIRECT DIAL:	(212) 756-2522	**Number of Pages:**	5
FILE NO.:	005231.0003		

Applicant(s): John S. Yates, Jr., et al.
Serial No.: 09/385,394 Art Unit: 2183
Filed: August 30, 1999 Examiner: Richard Ellis
Title: COMPUTER WITH TWO EXECUTION MODES

AFTER FINAL – EXPEDITED PROCEDURE

I hereby certify that the attached

- This FAX cover sheet
- Renewed Request for Withdrawal of Finality of Office Action

along with any paper(s) referred to as being attached or enclosed) are being transmitted by facsimile on March 9, 2003 to the Commissioner for Patents, Box AF, Washington, D.C. 20231.

Dated: March 9, 2003

By: David E. Boundy
Registration No. 36,461

For incomplete transmission please call (212) 756-2000 ext.6076

9395951.1

#15
3-11-03
OW

PATENT DOCKET NO. 5231.03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 2183

Examiner: Richard Ellis

Serial No.: 09/385,394

Filed: August 30, 1999

Applicant(s): John S. Yates, Jr., et al.

Title: COMPUTER WITH TWO EXECUTION MODES

I certify that this correspondence, along with any documents referred to therein, is being transmitted by facsimile on March 9, 2003 to The Commissioner for Patents, Box AF, Washington D.C. 20231.

David E. Boodey

COMMISSIONER FOR PATENTS
Box AF
Washington D.C. 20231

AFTER FINAL – EXPEDITED CONSIDERATION

RENEWED REQUEST FOR WITHDRAWAL OF FINALITY OF ACTION OF OCTOBER 1, 2002

Dear Examiner Ellis:

Applicant writes in response to an Advisory Action of February 10, 2003. There are several reasons that the Office Action of October 1, 2002 (paper 11) cannot be final, and that the amendment filed December 2, 2002 must be entered.

The reason Applicant presses these procedural points is that the procedural omissions mask a number of substantive issues: omissions of explicit claim limitations, and several instances where the Examiner's understanding of the Richter '684 reference is incorrect. Until these claims have had at least one careful consideration of all their limitations, and the Examiner has given similarly careful consideration to the Richter '684 reference (at the very least, to reconcile his view of Richter '684 with those portions of Richter '684 cited in Applicant's papers showing the inconsistency between the explicit teaching of Richter '684 and the Examiner's inferences), the issues are not properly developed for appeal, and finality is premature.

First, claim 104 recites that the hardware "enforc[es] a requirement that the memory regions be necessarily disjoint." Paragraph 31(F) of the October Office Action admits that the relevant memory regions in the Richter '684 reference "may overlap." "Necessarily disjoint" is the opposite of "may overlap." The "necessarily disjoint" claim limitation has never received the Examiner's careful consideration, and final rejection is premature.

Second, the Office Action omits any discussion of "reasonable expectation of success" for any of the § 103(a) issues raised. The "Response to Office Action" of December 2, 2002 points out several reasons that the modification proposed in the October Action cannot result in a workable system (see, *e.g.*, pages 5-10). The February 2003 Advisory Action (bottom of page 1) explicitly concedes that no attempt has been made to show "reasonable expectation of success."

MPEP § 2143 uses the word "must" twice to indicate that such a showing is always mandatory, and MPEP § 706 indicates that "The standards of patentability applied in the examination of claims must be the same throughout the Office."

The Director imposed this procedural requirement in order to ensure that an examiner's technological analysis would be correct and complete. By omitting any consideration of "reasonable expectation of success," examination has glossed over a host of substantive technological impossibilities, as discussed in more detail in Applicant's December 2002 papers. Any rejection must describe some particular implementation that is (a) workable, (b) supported by the reference, and (c) that falls within the claims. Until there is some showing of "enablement of the reference" for such an implementation, there can be no anticipation. Until there is some showing of "reasonable expectation of success" for such an implementation, there can be no obviousness.

Applicant does not have the power to overrule the Director to excuse the "reasonable expectation of success" requirement of MPEP §§ 2143 and 2143.02. If the PTO has issued a written Order or Notice that amends this requirement of the MPEP, Applicant requests a FAX copy at (212) 593-5955. In absence of such a written Order or Notice, Applicant is entitled to a showing of "reasonable expectation of success" before any obviousness rejection may be made final.

Third, several of the written § 102 rejections in the first Office Action were so incomplete that the second Office Action constitutes a "new ground of rejection" of unamended claims that cannot be made final.

For example, the first Action of February 2002 makes no showing that the "altering a data storage content of the computer" of claim 22 is either expressly shown in Richter '684 or inherent. The first Action discusses this limitation only in the context of claim 1 (first Action, ¶ 7(D)). But claim 1 recites two alternatives, and the written rejection makes no indication which of the two is thought to appear in Richter '684. There is no explicit discussion directed squarely to the "altering storage" limitation. The October 2002 Action contains no further discussion or elaboration of claim 22. The only tangential discussion in any of either Office Action appears in ¶ 28 of the October 2002 Action, where it is conceded that, at best, a somewhat-similar limitation in claim 101 is only inherent in Richter '684, not explicit. The October concession confirms that the first Action provided neither a showing of explicit teaching nor any "rationale or evidence tending to show inherency" as required by MPEP § 2112. The only fair reading of the first Action is that this "altering storage" claim limitation was simply overlooked. Therefore, the § 102 rejection of claim 22 was incomplete in the first Action.

Applicant's paper of June 2002 amended claim 22 into independent form for the sole purpose of bringing this limitation to the Examiner's attention. The "five lines" of new text mentioned in the February 2003 Advisory Action are incorporated from claim 22's parent claims; they introduce no new issues. Further, unamended language can almost never be newly-rejected and finally rejected – to support finality, the new rejection must be "necessitated by amendment."

There has never been any discussion in either Office Action directed squarely to the "altering a data storage content of the computer" limitation of claim 22. Thus, finality of the Office Action of October 2002 is premature.[1]

For each of these three reasons, finality of the October 2002 Action was premature. In view of the short period remaining for response, Applicant requests confirmation either by email or by phone during the week of March 10, 2003, that finality is withdrawn, and that the

[1] Indeed, any direct discussion of this limitation in any future Action will be the first, which will in turn prevent finality of that Action as well.

amendment of December 2002 is being entered and given full consideration. If the Examiner still believes that finality is proper, or if he would like to discuss any of these issues further, he is requested to phone the undersigned at (212) 756 2522.

Kindly charge any additional fee, or credit any surplus, to Deposit Account 50-0675, Order No. 5231.03-4000.

Respectfully submitted,

SCHULTE ROTH & ZABEL, LLP

Dated: March 9, 2003

By: David E. Boundy
David E. Boundy
Registration No. 36,461

Mailing Address:
SCHULTE ROTH & ZABEL, LLP
919 Third Avenue
New York, New York 10022
(212) 756-2000
(212) 593-5955 Telecopier